



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

STERNE KESSLER GOLDSTEIN & FOX PLLC  
ATTORNEYS AT LAW  
1100 NEW YORK AVENUE N W SUITE 600  
WASHINGTON DC 20005-3934

**COPY MAILED**

**SEP 21 2009**

**OFFICE OF PETITIONS**

In re Application of	:	
Okada et al.	:	
US Patent No. 6,938,718 B1	:	
Issued: September 6, 2005	:	DECISION
Application No. 09/474,127	:	
Filed: December 29, 1999	:	
Attorney Docket No. 0666.023000E	:	

The above-identified application has been forwarded to the undersigned for review of the patent term extension information printed on the face of the patent due to the suspensions in prosecution by the Office to await the outcome of an interference due to Applicant's request for a refund of a maintenance fee payment received on June 19, 2009, due to expiration of the patent prior to payment of the maintenance fee.

On April 5, 2001, a first Letter of Suspension to await the outcome of an Interference was mailed by the Office.

On November 11, 2001, a second Letter of Suspension to await the outcome of an Interference was mailed by the Office.

On September 6, 2002, a third Letter of Suspension to await the outcome of an Interference was mailed by the Office.

On April 2, 2003, a first Office Action on the merits was mailed by the Office.

35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in utility and plant applications filed on or after June 8, 1995, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for other specifically defined administrative delays in utility and plant applications filed on or after May 29, 2000.

The above-identified application was filed on December 29, 1999. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995.

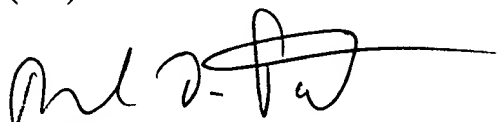
The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

According to 37 CFR 1.701 (c)(1)(ii), the application is entitled to patent term extension for the number of days, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

The period of delay in the above-identified patent is the period beginning on April 4, 2001, the date that the first Letter of Suspension was mailed, and ending on April 2, 2003, the date of the first Office Action on the merits. Three years after the earliest effective filing date of the application is February 1, 1992. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the period of extension is 728 days, which is the period from April 5, 2001 to April 2, 2003, including the beginning and end dates.

The Office proposes to issue a certificate of correction in order to rectify the error regarding the patent term extension information. See 35 U.S.C. 254 and 37 CFR 1.322. Applicant is given THIRTY (30) DAYS to respond to this letter. If no objection is received from applicant, the Office will issue a certificate of correction indicating that the patent term is extended for 728 days under 35 U.S.C. 154(b). This time limit is NOT extendible under 37 CFR 1.136

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

A handwritten signature in black ink, appearing to read 'Mark O. Polutta', with a long horizontal line extending to the right.

Mark O. Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy